

## **REMARKS**

This paper is presented in response to the Office Action. By this paper, claims 1, 4, 8, 9-15 and 36 are amended and new claims 37-43 are added. Claims 1-43 are pending in view of the aforementioned new claims.

Reconsideration of the application is respectfully requested in view of the aforementioned amendments and the following remarks. For the Examiner's convenience and reference of the Examiner, Applicant's remarks are presented in the order in which the corresponding issues were raised in the Office Action.

### **I. General Considerations**

Applicant notes that the remarks and amendments presented herein have been made merely to clarify the claimed embodiments from elements purported by the Examiner to be taught by the cited references. Such remarks, or a lack of remarks, and amendments are not intended to constitute, and should not be construed as, an acquiescence, on the part of the Applicant: as to the purported teachings or prior art status of the cited references; as to the characterization of the cited references advanced by the Examiner; or as to any other assertions, allegations or characterizations made by the Examiner at any time in this case. Applicant reserves the right to challenge the purported teaching and prior art status of the cited references at any appropriate time.

In addition, the remarks herein do not constitute, nor are they intended to be, an exhaustive enumeration of the distinctions between any cited references and the claimed invention. Rather, the distinctions identified and discussed herein are presented solely by way of example. Consistent with the foregoing, the discussion herein is not intended, and should not be construed, to prejudice or foreclose contemporaneous or future consideration, by the Applicant, of additional or alternative distinctions between the claims of the present application and any references cited by the Examiner, and/or the merits of additional or alternative arguments.

### **II. Rejection of Claim 1, 2, 7-15 and 36 under 35 U.S.C. § 102**

Applicant respectfully notes that a claim is anticipated under 35 U.S.C. § 102(a), (b), or (e) only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Further, the identical invention must be shown in as complete detail as is contained in the claim. Finally, the elements must be arranged as required by the claim. *MPEP* § 2131.

**a. claims 1, 2 and 7**

The Examiner has rejected claims 1 and 7 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,644,853 to Kantor et al. ("*Kantor*"). The Examiner has also rejected claims 1, 2 and 7 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 3,992,633 to Braun et al. ("*Braun*"). Applicant respectfully disagrees but submits that in light of the discussion set forth below, the rejection is moot and should be withdrawn.

By this paper, Applicant has amended independent claim 1 to recite in part "...a second mounting portion that mechanically attaches to a portion of the evacuated enclosure, the second mounting portion being at least partially received within the first mounting portion ..." Support for this amendment to claim 1 can be found, for example, at least at paragraphs [0013] and Figure 2b of the application.

In contrast, the Examiner has not established that *Kantor* nor *Braun* either separately or in combination with each other or any other reference(s), teaches or suggests the aforementioned limitation in combination with the other limitations of claim 1.

In light of the foregoing, Applicant respectfully submits that the Examiner has not established that *Kantor* or *Braun* anticipates claim 1, at least because the Examiner has not established that each and every element as set forth in claim 1 is found in *Kantor* or *Braun*, because the Examiner has not established that the identical invention is shown in *Kantor* or *Braun* in as complete detail as is contained in amended claim 1, and because the Examiner has not shown that *Kantor* or *Braun* discloses the elements of claim 1 arranged as required by that claim.

Applicant thus respectfully submits that the rejection of claim 1, as well as the rejection of corresponding dependent claims 2 and 7, should be withdrawn.

**b. claims 8-15**

The Examiner has rejected claims 8, 9 and 12-15 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,303,283 to Jedlitschka et al. ("*Jedlitschka*"). The Examiner has also rejected claims 8-15 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,492,780 to Okada ("*Okada*"). Applicant respectfully disagrees but submits that in light of the discussion set forth below, the rejection is moot and should be withdrawn.

By this paper, Applicant has amended independent claim 8 to now be directed to "an x-ray tube" which requires in part "...an evacuated enclosure containing an electron source and an anode positioned to receive electrons produced by the electron source; an outer housing containing the evacuated enclosure; and a mounting assembly, a substantial portion of the mounting assembly being positioned outside the outer housing..." Support for this amendment to claim 8 can be found, for example, at least at Figures 1, 7B, 8B and 9 and the related discussion in the application.

In contrast, the Examiner has not established that *Jedlitschka* nor *Okada* either separately or in combination with each other or any other reference(s), teaches or suggests the aforementioned limitation in combination with the other limitations of claim 8.

In light of the foregoing, Applicant respectfully submits that the Examiner has not established that *Jedlitschka* or *Okada* anticipates claim 8, at least because the Examiner has not established that each and every element as set forth in claim 8 is found in *Jedlitschka* or *Okada*, because the Examiner has not established that the identical invention is shown in *Jedlitschka* or *Okada* in as complete detail as is contained in amended claim 8, and because the Examiner has not shown that *Jedlitschka* or *Okada* discloses the elements of claim 8 arranged as required by that claim.

Applicant thus respectfully submits that the rejection of claim 8, as well as the rejection of corresponding dependent claims 9-15, should be withdrawn.

**c. claim 36**

The Examiner has rejected claim 36 under 35 U.S.C. § 102(b) as being anticipated by *Okada*. Applicant respectfully disagrees but submits that in light of the discussion set forth below, the rejection is moot and should be withdrawn.

By this paper, Applicant has amended independent claim 36 to recite in part "...a clamp portion that is at least partially received within the recess and positioned on the seat when the clamp portion and the bracket portion are in an assembled state, the clamp portion further defining an aperture that is substantially aligned with the aperture of the bracket portion, and the clamp portion and bracket portion being configured such that a size of the bracket aperture is substantially unaffected by a change in size of the clamp aperture..." Support for this amendment to claim 36 can be found in the application at, for example, paragraphs [0045] to [0047], paragraph [0065], and Figures 2B, 4D and 6.

In contrast, the Examiner has not established that *Okada* either separately or in combination with any other reference(s), teaches or suggests the aforementioned limitation in combination with the other limitations of claim 36.

In light of the foregoing, Applicant respectfully submits that the Examiner has not established that *Okada* anticipates claim 36, at least because the Examiner has not established that each and every element as set forth in claim 36 is found in *Okada*, because the Examiner has not established that the identical invention is shown in *Okada* in as complete detail as is contained in amended claim 36, and because the Examiner has not shown that *Okada* discloses the elements of claim 36 arranged as required by that claim.

Applicant thus respectfully submits that the rejection of claim 36 should be withdrawn.

### **III. Rejection of Claims 2 and 3 under 35 U.S.C. § 103**

Applicant respectfully notes at the outset that in order to establish a *prima facie* case of obviousness, it is the burden of the Examiner to demonstrate that three criteria are met: first, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; second, there must be a reasonable expectation of success; and third, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *MPEP* § 2143.

The Examiner has rejected claims 2 and 3 under 35 U.S.C. § 103(a) as being unpatentable over *Kantor* as applied to claim 1 above. The Examiner has also rejected claim 3 under 35 U.S.C. § 103(a) as being unpatentable over *Braun* as applied to claim 2 above. Applicant respectfully disagrees.

Claims 2 and 3 depend from claim 1, which, as noted previously, has been amended herein. By virtue of their dependence from independent claim 1, dependent claims 2 and 3 each require "...a second mounting portion that mechanically attaches to a portion of the evacuated enclosure, the second mounting portion being at least partially received within the first mounting portion..."

As discussed at II. above however, the Examiner has not established that the aforementioned limitation, in combination with the other limitations of the rejected claims, is taught or suggested by *Kantor* or *Braun* or by any other reference(s). Thus, even if the purported disclosures of *Kantor* or *Braun* are modified in the allegedly obvious fashion advanced in the Office Action, the resulting combinations nonetheless fail to include all the limitations of the rejected claims.

In light of the foregoing, Applicant respectfully submits that the Examiner has failed to establish a *prima facie* case of obviousness with respect to claims 2 and 3, at least because the Examiner has not established that the purportedly obvious modifications of *Kantor* and *Braun* result in combinations that include all the limitations of either claim 2 or 3. Applicant thus respectfully submits that the rejections of claims 2 and 3 should be withdrawn.

### **IV. Allowed Subject Matter**

Applicant acknowledges with thanks the indication of the Examiner that claims 16-35 are allowed, and Applicant also wishes to thank the Examiner for the careful review of those claims.

The Examiner has indicated that claims 4-6 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. In light of the discussion herein, Applicant respectfully declines to rewrite claims 4-6 at this time.

Applicant submits the following comments concerning the Examiner's statements of reasons for the indication of allowable subject matter in the Office Action. In general, Applicant agrees with the

Examiner that the inventions to which claims 4-6 and 16-35 are respectively directed are patentable over the cited references, but respectfully disagrees with the Examiner's statement of reasons for allowance as set forth in the Office Action.

Particularly, Applicant submits that it is improper to characterize a single limitation, or subset of limitations, as constituting the basis for allowance of a claim. Rather, the patentability of a claim is properly determined with reference to the claim *as a whole*. Accordingly, Applicant does not concede that the reasons for allowable subject matter given by the Examiner are the only reasons that make, or would make, the claim allowable and Applicant does not make any admission or concession concerning the Examiner's statements in the Office Action concerning the allowability of claims 4-6 and 16-35 in view of the cited references.

### **CONCLUSION**

In view of the remarks submitted herein, Applicant respectfully submits that each of the pending claims 1-43 is in condition for allowance. Therefore, reconsideration of the rejections is requested and allowance of those claims is respectfully solicited. In the event that the Examiner finds any remaining impediment to a prompt allowance of this application that could be clarified in a telephonic interview, the Examiner is respectfully requested to initiate the same with the undersigned attorney.

Dated this 1<sup>st</sup> day of December 2006.

Respectfully submitted,

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